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| EXAMINER NGUYEN, SON T | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,114

Applicant(s)

HEIDECKE ET AL.

Examiner

SON T. NGUYEN

Art Unit

3643

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or, cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 1, applicant's original disclosure failed to support the limitation of "only one radial slot". Nothing in the specification described in detail this limitation and/or the criticality of it.

2173.05(i) Negative Limitations

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of

negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3,5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE951119, on form PTO-1449, herein DE119).

For claim 1, DE119 teaches a device for treating woody plants, comprising a cylindrical injection element (see figs. 1-6) equipped with an axial bore (15,38); a radial slot (fig. 4, where ref. 15a is pointing at or fig. 6 where the arrows are located in area of refs. 14,14a) which communicates with the above bore and whose longitudinal axis is essentially parallel to the axial bore; a fixing element (14b,17,or 21,23) and an element (12) for connecting a reservoir (1).

However, DE119 is silent about only one radial slot. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have only one radial slot in the device of DE119, depending on the user's preference to do so based on how much liquid he/she wishes to inject out of the device.

For claim 2, DE119 teaches the axial bore is embodied in the form of a pot bore (see figs. 1,4).

For claim 3, DE119 teaches a sealing element (18) is arranged between the fixing element and the element for connecting a reservoir.

For claim 5, DE119 teaches the fixing element is a thread (ref. 7 is a thread to fit in ref. 16).

For claim 6, DE119 teaches an element for turning and/or adjusting (16,22) the

device, wherein the fixing element (21,23) is arranged between the radial slot (15a) and the element for turning and/or adjusting (16). See fig. 6.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE119 as applied to claim 1 above, and further in view of Mazur et al. (4908983).

DE119 is silent about a marker element, which indicates the position of the radial slot is provided behind the fixing element; wherein the fixing element is arranged between the marker element and the radial slot.

Mazur et al. teach a marker element (99), which indicates the position of a cap (98) for alignment with the marker element so as to inject specific amount of fluid from the injector. It would be obvious for one of ordinary skill in the art to employ a marker element as taught by Mazur et al. to indicate the position of the radial slot being provided behind the fixing element in the apparatus of DE119, since known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007). In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the fixing element of DE119 as modified by Mazur et al. be arranged between the marker element and the radial slot, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Arguments

7. Applicant's arguments filed 4/19/2011 have been fully considered but they are not persuasive.

Applicant argued that the Examiner has objected to claim 4 as being an improper multiple dependent claim, and has not further treated this claim on the merits. Applicants respectfully submit that claim 4 is not improper. Claim 4 is not a multiple dependent claim. Claim 4 depends from claim 3 only. Claim 3 is a proper multiple dependent claim which depends from "claim 1 or 2." See MPEP 608.01 (n).

Claim 4 is improper because it depends on a multiple dependent claim, which is claim 3. See the underlined in the above claim 4 objection under 37 CFR 1.75(c).

Applicant argued that present independent claim 1 recites a device for treating woody plants comprising, inter alia, "only one radial slot which communicates with the axial bore." In contrast to the presently claimed invention, DE119 discloses a plurality of radial slots (at 15a) provided on the external circumference that are intended to facilitate the injection of a substance.

First of all, as stated in the above 112 rejection, the negative limitation of "only one radial slot" is not supported in applicant's original disclosure, thus, it is new matter. Second, there is no criticality as originally explained in the specification as to why applicant only employed one slot. Explaining the criticality in the current remarks is not sufficient because if it is an important feature of the invention, then it should have been explained in the original disclosure. It appears that the explanation provided in the remarks filed 4/19/2011 is merely an opinion to just overcome the DE119 reference.

Finally, page 2, lines 22-23, of the specification stated that the slot can be replaced by a plurality of bores, thus, clearly, this demonstrate that there is no criticality as to only one slot. It appears that it is a mere personal preference of the user based on his/her choice for the intended use of the device.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON T. NGUYEN whose telephone number is (571)272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SON T NGUYEN/
Primary Examiner, Art Unit 3643